

App. Serial No 10/561,627
NL021504 US

Remarks

Claims 1-21 are currently pending in the patent application. For the reasons and arguments set forth below, Applicant respectfully submits that the claimed invention is allowable over the cited references.

In the instant Office Action dated July 9, 2007, the following rejections are noted: claims 9-11 stand rejected under 35 U.S.C. 112(2); claim 14 stands rejected under 35 U.S.C. 101; claims 1-7, 12, 13, and 15-19 stand rejected under 35 U.S.C. 103(a) over Garg et al. (U.S. Patent No. 5,493,687) in view of Boice et al. (U.S. Patent No. 6,301,671); and claims 8-10, 20 and 21 stand rejected under 35 U.S.C. 103(a) over Garg in view of Boice, and further in view of Gupta et al. (U.S. Patent No. 5,996,083).

Applicant respectfully traverses the Section 112(2) rejection of claims 9-12 because the claims do particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant notes that explicit antecedent basis is not required. *See* M.P.E.P. § 2173.05(e). Notwithstanding, in an effort to facilitate prosecution, Applicant has amended these claims to recite "the support register" for which antecedent basis can be found in lines 1-2 of claim 9. Thus, Applicant requests that the Section 112(2) rejection of claims 9-12 be withdrawn.

Applicant respectfully traverses the Section 101 rejection of claim 14. The Office Action improperly bases the rejection on a partial interpretation of part of an element of the claim, while ignoring the claim as a whole. According to M.P.E.P. § 2106(II)(C), "[W]hen evaluating the scope of a claim, every limitation in the claim must be considered. USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered. *See, e.g., Diamond v. Diehr*, 450 U.S. 175, 188-89, 209 USPQ 1, 9 (1981)". The claim as a whole is directed to a signal-bearing medium, which is recognized as statutory subject matter as is evidenced by a search of the USPTO's own database, which includes over 250 issued patents that claim a "signal-bearing medium." *See, e.g., U.S. Patent Numbers 7,072,824, 7,027,830 and 6,880,040.* Therefore, the Section 101 rejection of claim 14 is improper and Applicant requests that it be withdrawn.

Applicant respectfully traverses the Section 103(a) rejection of claims 1-7, 12, 13, and 15-19 because the cited portions of the Boice reference do not correspond to the

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claimed invention which includes, for example, aspects directed to gating off the clock, address and data inputs of a register bank. The Office Action acknowledges that the Garg reference does not teach enable logic for gating off the clock, address and data inputs of a register bank. In an attempt to cure this deficiency, the Office Action cites to portions of the Boice reference; however, these portions of Boice do not teach gating off the clock, address and data inputs of on-chip memory array 200 as asserted by the Office Action. The cited portions of Boice instead teach gating the clock input of on-chip memory array 200 (*see, e.g.*, Figure 7a) and using two control signals (210 and 212) to select whether the values stored in address/data register 209 should be updated or hold their previous values (*see, e.g.*, Figure 8 and Col. 10:43-63). Boice's address/data register 209 receives a free running oscillator signal 11 (*i.e.*, the clock input of address/data register 209 is not gated off). The cited portions of Boice do not teach gating off the address/data information received by on-chip memory array 200 from address/data register 209. Thus, the Boice reference does not teach gating off the clock, address and data inputs of a register bank as in the claimed invention. Accordingly, the Section 103(a) rejection of claims 1-7, 12, 13, and 15-19 is improper and Applicant requests that it be withdrawn.

Applicant respectfully traverses the Section 103(a) rejection of claims 8-10, 20 and 21 because the cited combination of the Garg and Boice references does not correspond to the claimed invention as discussed above in relation to the Section 103(a) rejection of claims 1 and 15. In at least this regard, the rejection of claims 8-10, 20 and 21 is improper in that these claims depend from claim 1 or claim 15. Therefore, Applicant requests that the Section 103(a) rejection of claims 8-10, 20 and 21 be withdrawn.

Applicant notes that minor amendments have been made to claims 1, 3 and 4 to improve readability. These amendments are not being made to overcome the rejections raised by the Office Action, which fail for the reasons discussed above.

The undersigned has recently been made aware of a similar application, U.S. Application No. 10/561,627 to Terechko *et al.* that was filed on Dec. 3, 2003. This disclosure is made in an abundance of caution and is not intended to be an admission as to the relevance of this application.

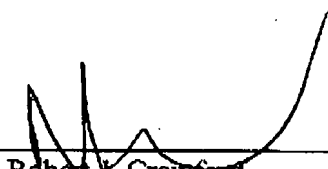
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In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Peter Zawilski, of NXP Corporation at (408) 474-9063 (or the undersigned).

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